



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Ech

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/336,266 06/14/99 BEMIS

G VPI/96-16.CI

┌

HM12/1106

┐

EXAMINER

RAO, D

ART UNIT	PAPER NUMBER
----------	--------------

JAMES F HALEY JR
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK NY 10020

1624

13

DATE MAILED: 11/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/336,266

Applicant(s)
Bemis et al.

Examiner
Deepak Rao

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 27, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12, 15, and 18-67 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-12, 15, 24-38, 46-48, and 62-67 is/are allowed.
- 6) ☒ Claim(s) 18-23, 39-45, and 49-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1624

DETAILED ACTION

This office action is in response to the amendment filed on August 27, 2001.

Claims 4-12, 15 and 18-67 are pending in this application.

The following rejections are withdrawn:

The rejections under 35 U.S.C. 112, second paragraph of the previous office action are withdrawn in view of the amendments.

The rejections under 35 U.S.C. 102(e) of the previous office action is hereby withdrawn in view of the amendments.

The following rejections are necessitated by the amendment:

Claim Rejections - 35 U.S.C. § 112

Claim 44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 44 depends from claim 42 and recites the limitation "X is S", however, claim 42 does not recite the term X within the claim. On the other hand, claim 43 contains the definition of X. Therefore, claim 44 appears to be in better form if it depends from claim 43.

Note: (The above situation applies to claim 12 also which depends from claim 10, however, will be in better form if claim 12 depends from claim 11).

Art Unit: 1624

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39-45, 49-61 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bemis et al., U.S. Patent No. 6,147,080. The reference teaches a generic group of compounds, see formula (II) and (III) that are useful as pharmaceutical therapeutic agents (p38 inhibitors) and the species in Example 5, 7 and 8. The claims differ from the reference by reciting a specific species and/or a more limited genus than the reference, for example, the instant claims differ by having a different halogen in place of the chloro, etc. It would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the genus taught by the reference, including those instantly claimed, because the

Art Unit: 1624

skilled chemist would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole i.e., as pharmaceutical agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. v. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

Applicant excludes the compounds of the reference by proviso statement (in claim 39), however, the instantly claimed compounds are still obvious over the reference compounds for the following reasons:

(a) The generic formula of the instant claims permits a methyl group to be present on any of the carbons and therefore, differs from the reference compound by a -CH₂ group and thus, the instant compounds are homologs of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally similar compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. *In re Hass*, 60 USPQ 544 (CCPA 1944); *In re Henze*, 85 USPQ 261 (CCPA 1950).

Art Unit: 1624

(b) The genus according to the instant claims permits the substituents on positions different from the exemplified reference compounds. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are structural isomers of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally isomeric compounds are suggestive of one another and would be expected to share similar properties. It has been held that a compound which is structurally isomeric with a compound of prior art is prima facie obvious absent unexpected results. *In re Finley*, 81 USPQ 383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950). *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

Applicant can not rely on the priority benefit of the earlier applications to overcome the above rejection because the instant claims are not entitled for such priority benefit. See the "Note" in the previous office action at pages 5-6 which is provided below for convenience:

Note: It is acknowledged that the instant application which is continuation of PCT/US97/23392 which is a CIP of 08/862,925 filed June 10, 1997 which is a CIP of 08/822,373 filed March 20, 1997 which claims benefit of U.S. Provisional Application S.No. 60/034,288 filed December 18, 1996. It is noted however, that the instant claims are not entitled for the above priority date(s) because the instantly claimed invention is not fully supported in the prior applications, see the definitions of Q₃, Q₂, etc. in the instant claims wherein several of the substituent groups are not disclosed in the previous applications. For example, the substituents of Q₃ include 'N(R')C(O)R₄; N(R')C(O)OR₄; N(R')C(O)C(O)R₄;...' in the instant claims which are not disclosed in the prior applications (as can be seen from the definition of Q₁ in col. 2 of US'418 or US'080). Therefore, the instant claims are not entitled for the earlier date(s). See MPEP § 706.02.

Art Unit: 1624

Allowable Subject Matter

Claims 38, 4-12, 15, 24-37, 46-48 and 62-67 are allowed. The references of record do not teach or fairly suggest the instantly claimed compounds.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status

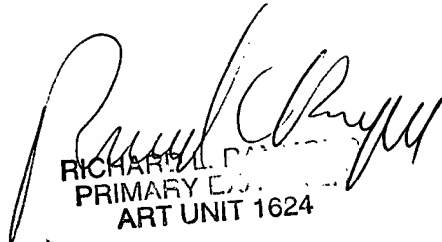
Application/Control Number: 09/336,266

Page 7

Art Unit: 1624

of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Deepak Rao 
November 4, 2001


RICHARD L. D...
PRIMARY EX...
ART UNIT 1624